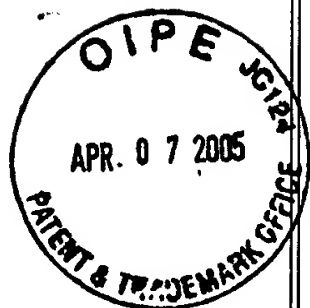


AF ZPW

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**



In re Appln. of: SERA

Serial No.: 09/855,149

Filed: May 14, 2001

For: Network Commerce System, Orderer Terminal Using the Same...

Group: 3625

Examiner: FADOK, MARK A.

DOCKET: NEC 142135

MAIL STOP APPEAL BRIEF -- PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

In connection with the above-entitled matter, enclosed please find the following:

1. Three copies of Appellant's Brief on Appeal and Appendix A, under Rule 192; and
2. Credit Card Payment Authorization Form PTO-2038 in the amount of \$500.00 to cover the cost of filing the Appeal Brief.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted

Norman P. Soloway
Attorney for Appellant
Registration No. 24,315

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

CERTIFICATE OF MAILING

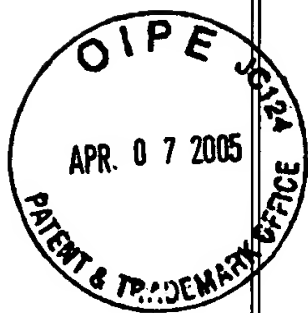
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 5, 2005, at Tucson, Arizona.

By Linda Vaubel

NPS/ALK:lv

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Appln. of: SERA

Serial No.: 09/855,149

Filed: May 14, 2001

For: Network Commerce System, Orderer Terminal Using the Same...

Group: 3625

Examiner: FADOK, MARK A.

DOCKET: NEC 142135

MAIL STOP APPEAL BRIEF -- PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

~~04/08/2005-EFLORES-00000027-09855149~~

~~01-FC-1402~~

~~500-00-0P~~

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

TABLE OF CONTENTS

APPELLANT'S BRIEF ON APPEAL	1
REAL PARTY IN INTEREST	1
RELATED APPEALS AND INTERFERENCES	2
STATUS OF THE AMENDMENTS	2
STATUS OF THE CLAIMS ON APPEAL	2
BACKGROUND OF THE INVENTION	2
SUMMARY OF THE INVENTION ON APPEAL.....	3
ISSUE PRESENTED ON APPEAL	5
THE FINAL ACTION	5
GROUPING OF CLAIMS	6
THE REFERENCE	6
Garfinkle et al., U.S. Patent No. 6,512,570 ("Garfinkle et al.").....	6
ARGUMENT ON APPEAL.....	6
CONCLUSION	12

APPENDIX A

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

TABLE OF CASES

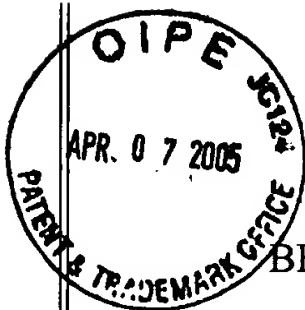
Verdegaal Bros. v. Union Oil Co. of California,
814 F.2d 682, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)..... 6

TABLE OF AUTHORITIES

35 U.S.C. § 102 5, 6
MPEP, Section 2131..... 6

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Appln. Of: SERA

Serial No.: 09/855,149

Filed: May 14, 2001

For: Network Commerce System, Orderer Terminal Using the Same...

Group: 3625

Examiner: FADOK, MARK A.

DOCKET: NEC 142135

MAIL STOP APPEAL BRIEF -- PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

This Brief is being filed in support of Appellant's Appeal from the Final Rejection by the Examiner, to the Board of Appeals and Interferences, the Notice of which was filed along with a one month extension of time on February 18, 2005.

REAL PARTY IN INTEREST

The Real Party in Interest for this Application is NEC Infrontia Corporation, having its principal place of business at 2-6-1 Kitamikata Takatsu-Ku, Kawasaki, 213-8511, JAPAN. NEC Infrontia Corporation received an Assignment of all right, title and interest in the Application through an Assignment from the original assignee NEC Corporation, recorded on Reel 012905/0639 on May 16, 2002. The original assignee NEC Corporation, received an Assignment of all right, title and interest in the Application through an Assignment executed by the Inventor Yoshinobu Sera on May 11, 2001 and by virtue of his employment by NEC

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

04/08/2005 EFLORES 00000027 09855149

01 FC:1402

500.00 OP

Corporation. The Assignment to NEC Corporation was recorded in the U.S. Patent and Trademark Office on May 14, 2001 at Reel 011816/0673.

RELATED APPEALS AND INTERFERENCES

To the best of the knowledge and the belief of the undersigned attorney and Appellant, there are no other appeals or interferences that would directly affect, or be directly affected by, or have bearing on, the Board's decision in the present Appeal.

STATUS OF THE AMENDMENTS

Appellant's Amendment B Under Rule 116 was entered by the Examiner in an Advisory Action mailed January 6, 2005.

STATUS OF THE CLAIMS ON APPEAL

Claims 1-18 stand finally rejected and are on Appeal. The claims on Appeal are set forth in **Appendix A** attached hereto.

BACKGROUND OF THE INVENTION

Information processing units e.g., personal computers, and communication lines e.g., the Internet, have become widespread, and information processing units are often used to order and purchase items or services using the aforementioned networks. A networked system can allow a user to order and purchase items through a catalog. And, some network systems allow a user to purchase items via one click operation, i.e., a system where a buyer registers and saves their name, address, and telephone number through a home page and then the buyer can purchase items without having to re-enter this information. (Specification, page 1, line 11 -- page 2, line 6).

In these types of prior art systems, because a variety of items or services handled through the network, a buyer has to consume time to determine which sellers on the network

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

handle their desired items and then which seller the buyer would like to use. Also, since the buyer may be different from the recipient of an item, and/or the location of the buyer may be different from that of the recipient, current systems are unable to efficiently connect sellers within a close proximity to a recipient. Moreover, prior art systems cannot selectively determine sellers capable of accepting the requirements of a buyer, e.g., the quick delivery of items or producing and processing items for low cost. (Specification, page 2, lines 7-22).

SUMMARY OF THE INVENTION ON APPEAL

An electronic commerce system according to the present invention includes a plurality of orderer terminals, member's shop terminals that are producing/processing terminals, a service headquarters terminal that is a headquarters apparatus, a payment terminal, and a network i.e., the internet, interconnecting these elements. (Specification, page 3, lines 13-22; FIG. 1).

A personal computer or workstation server is used for the orderer terminals and the member's shop terminals. A workstation server is used for the server headquarters terminal. Each member's terminal is handled at a member's shop, for example, a photo developer, in accordance with the order of the orderer terminal. Each member's terminal has the photo finishing service function and can print the photograph. (Specification, page 4, lines 7-14; page 9, lines 14-21; page 13, lines 6-16; FIG. 3).

As for the internal configuration of an orderer terminal, the orderer terminal includes a transmitter and a receiver. The transmitter transmits orders for image data and acoustic data in the form of digital data, and requests for editing digital data, development of a photograph, etc., to the service headquarters terminal via the network. The receiver receives services, i.e., a

finished photo, returned from the service headquarters terminal. (Page 9, line 22--page 10, line 8).

The service headquarters terminal includes an image data transmitter, a receiver, an order transmitter, a notice receiver, and a notifier. The image data transmitter transmits image data for inputting orders for the content of edited digital data, processing content, etc., to the orderer terminal via the network. The receiver receives digital data and orders transmitted from the orderer terminal. The order transmitter transmits the digital data and orders to the member's shop terminal selectively determined in accordance with the content of a received order. The notice receiver receives a notification regarding the fact that an item edited in accordance with an order from the member's shop terminal has been completely delivered and regarding the delivery expenses. The notifier notifies the payment terminal of a payment request notice to demand a payment of the editing charge and the delivery charge, based on the received notice. (Specification, page 4, line 14--page 5, line 1; page 10, line 9--page 11, line 1; FIG. 2).

The member's shop terminal includes a receiver, an editor, and a responder. The receiver receives digital data and an order of the orderer terminal transmitted via the service headquarters terminal. The editor edits and processes the digital data in accordance with the received order. The responder returns the fact that an edited item has been delivered, to the orderer terminal and to the service headquarters terminal. The payment terminal, which is an information processing unit installed in, for example, a financial institution, includes a receiver and a payment unit. The receiver receives a notice transmitted from the service headquarters terminal. The payment unit pays an amount of money corresponding to a received notice. (Specification, page 11, lines 2-16).

Each of the orderer terminal, the member's shop terminal, the service headquarters terminal, and the payment terminal has a modem that transmits and receives digital data via the network. A URL (Uniform Resource Locator) having a specific ID and a domain name is added to a home page opened by the service headquarters terminal. An orderer specifies the URL using the orderer terminal to access the home page opened by the service headquarters terminal. Thus, the orderer can receive services from the member's shop terminal. (Specification, page 11, line 17--page 12, line 2).

ISSUE PRESENTED ON APPEAL

The issue presented on Appeal is:

(1) Whether claims 1-18 are unpatentable under 35 USC § 102(e) as anticipated by Garfinkle et al. (US 6,512,570).

THE FINAL ACTION

In finally rejecting the claims on Appeal, the Examiner states the following:

“Garfinkle discloses a network commerce system comprising:
an orderer terminal for interaction with an orderer ordering an item or service (FIG 1 Item 8);
a plurality of producing/processing terminals each for interaction with a producer/processor (FIG 1, Item 12);
said producer/processor producing and processing said item or providing a produced and processed item, in accordance with an order from said orderer terminal (FIG 5B);
wherein said orderer terminal and said producing/processing terminal are interconnected via said network (FIG 1); and
a headquarters terminal including a receiver for receiving an order from said orderer terminal transmitted via said network (FIG 1, Interfaces, A, B and C); and
a transmitter for transmitting the order received by said receiver to a producing/processing terminal via said network (col 10 —lines 15-40);
said headquarters terminal selectively determining said producing/processing terminal in accordance with a received order and then making the selected producing/processing terminal produce and process said item or provide a produced and processed item (FIG 5A-F and col 10, lines 15-40).” (Underlining in original).

GROUPING OF CLAIMS

The claims on Appeal are set forth in **Appendix A** attached hereto.

Claims 1-18 are grouped together as containing the same essential patentable limitations, and thus stand or fall together.

THE REFERENCE

Garfinkle et al., U.S. Patent Number 6,512,570 (Garfinkle et al.)

Garfinkle et al. is directed to a method of processing a digital image from a photographic image and distributing a visual print produced from the digital image. The method includes the steps of storing the digital image of the photographic image on an image server at a first location. Selective authorized access to the digital image of the photographic image from a second location is facilitated. Orders are received for a visual print of the photographic image from the second location. Based upon the orders, a visual image is produced from the stored digital image at the first location in response to the at least one order.

ARGUMENT ON APPEAL

THE REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 102(E) AS ANTICIPATED BY GARFINKLE ET AL. IS IMPROPER BECAUSE GARFINKLE DOES NOT TEACH ALL OF THE FEATURES OF APPELLANT'S CLAIMS

The rejection of claims 1-18 under 35 USC §102 as anticipated by Garfinkle et al. (U.S. Patent No. 6,512,570), is in error. As this Board is well aware, anticipation under 35 USC 102 requires that a single reference teach every element of the claim MPEP 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference". *Verdegaal Bros. v. Umon Oil Co. of California*, 814F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir 1987). As will be seen below, Garfinkle et al. fails to meet this test.

Independent claim 1 requires a headquarters terminal that includes "a receiver for receiving an image data order from said orderer terminal transmitted via said network and a transmitter for transmitting the order received by said receiver to a producing/processing terminal via said network." In other words, the headquarters terminal is the center of the system, storing images and providing the interface between customers, sellers, and payment centers. This type of structure is illustrated by FIG. 2 of the instant application, which is reproduced below for the convenience of the Board as follows:

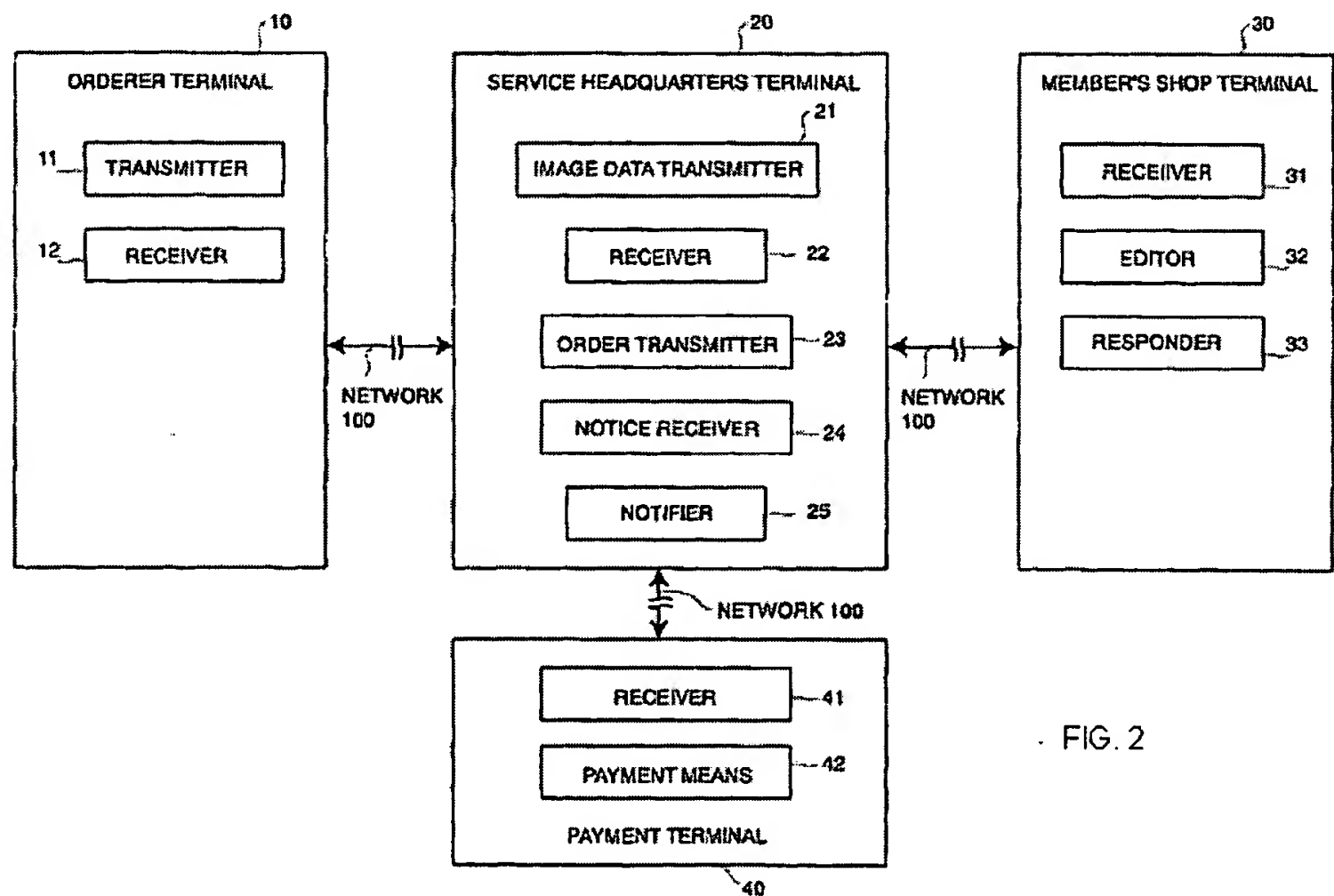
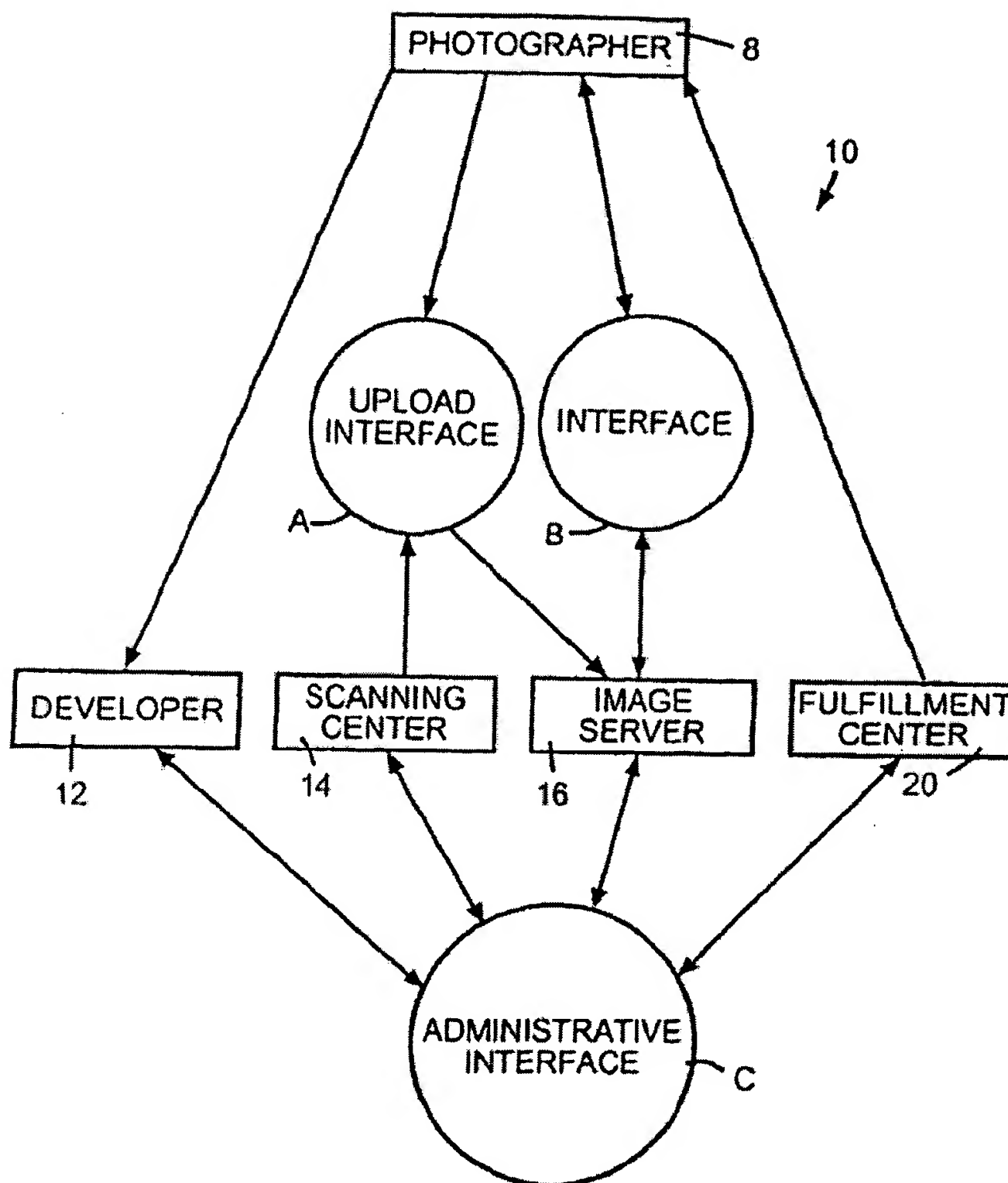


FIG. 2

Garfinkle et al. does not teach this structure! Garfinkle et al. teaches images that are uploaded to an image server via an upload interface A, viewed by a developing center, user or vendor using a separate interface B, and are managed by an administrative interface C. See Garfinkle et al. FIG. 1, which is reproduced below for the convenience of the Board:



The Examiner contends the separate Interfaces A, B and C of Garfinkle et al. are equivalent to the headquarter terminal of claim 1. This is not so. According to Garfinkle et al., Interfaces A, B and C access a database to manage the image server 16 (Column 7, lines 6-65). Nowhere does Garfinkle et al. describe that these interfaces are integrated together in the same subsystem as required by claim 1. In fact, Garfinkle et al. clearly intends for Interfaces A, B and C to be completely separate “functional blocks”, and provides separate flow charts for each

of these interfaces (see FIGs. 4; 5; 7). For example, Garfinkle et al. describes Interface A, i.e., the upload interface, in a flow chart that includes a block that accesses a separate image server and the photographer's computer terminal or scanning center. These features are highlighted by blocks 3a and 3f in FIG. 3 of Garfinkle et al. which is reproduced below for the convenience of the Board:

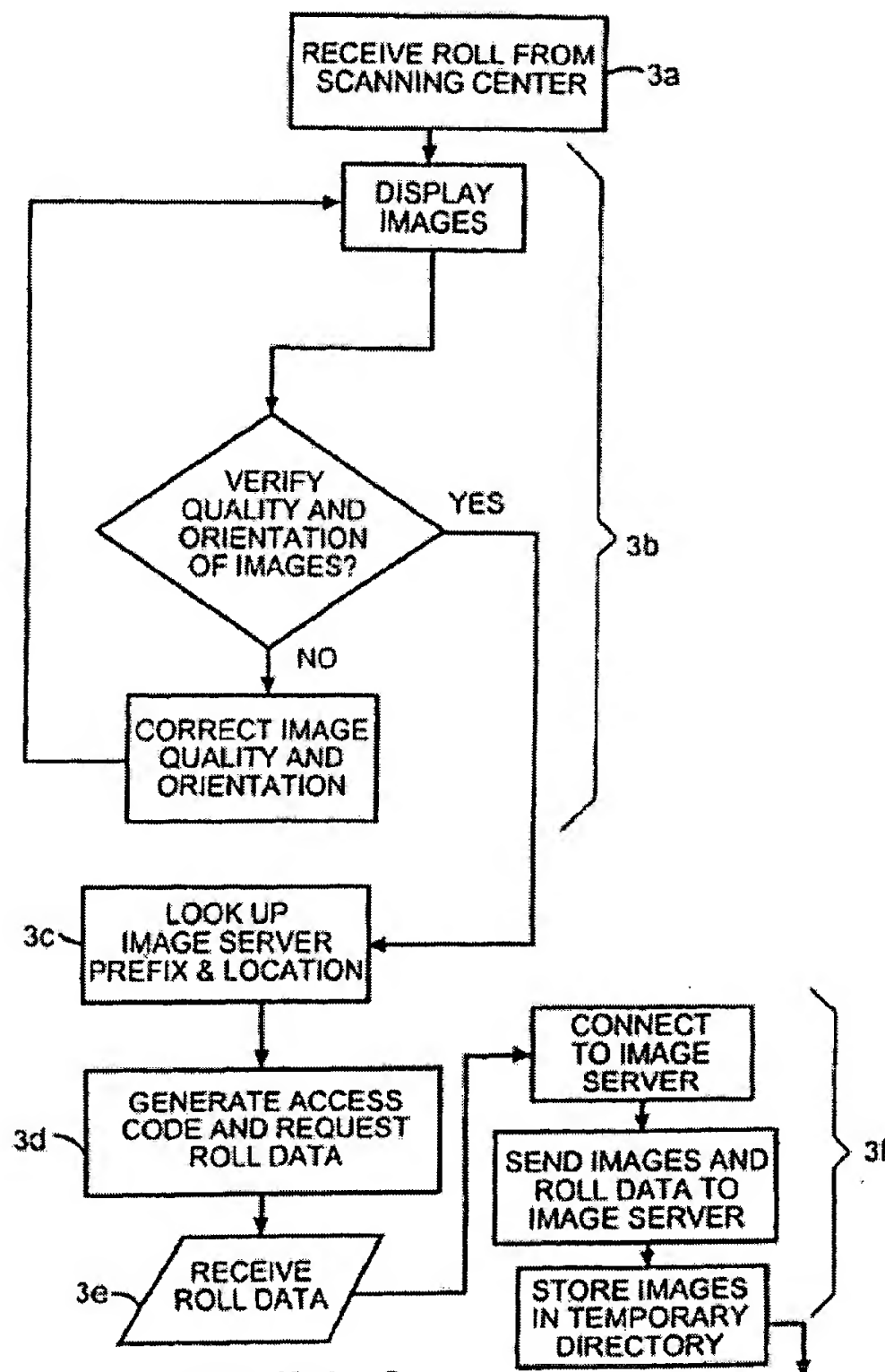


FIG. 3

Interface B interacts with the image server and photographer for viewing only, but does not interact with the fulfillment center, developer, or scanning center, or Interfaces A and C as highlighted below in Garfinkle et al.'s FIG. 8 which is produced below for the convenience of the Board:

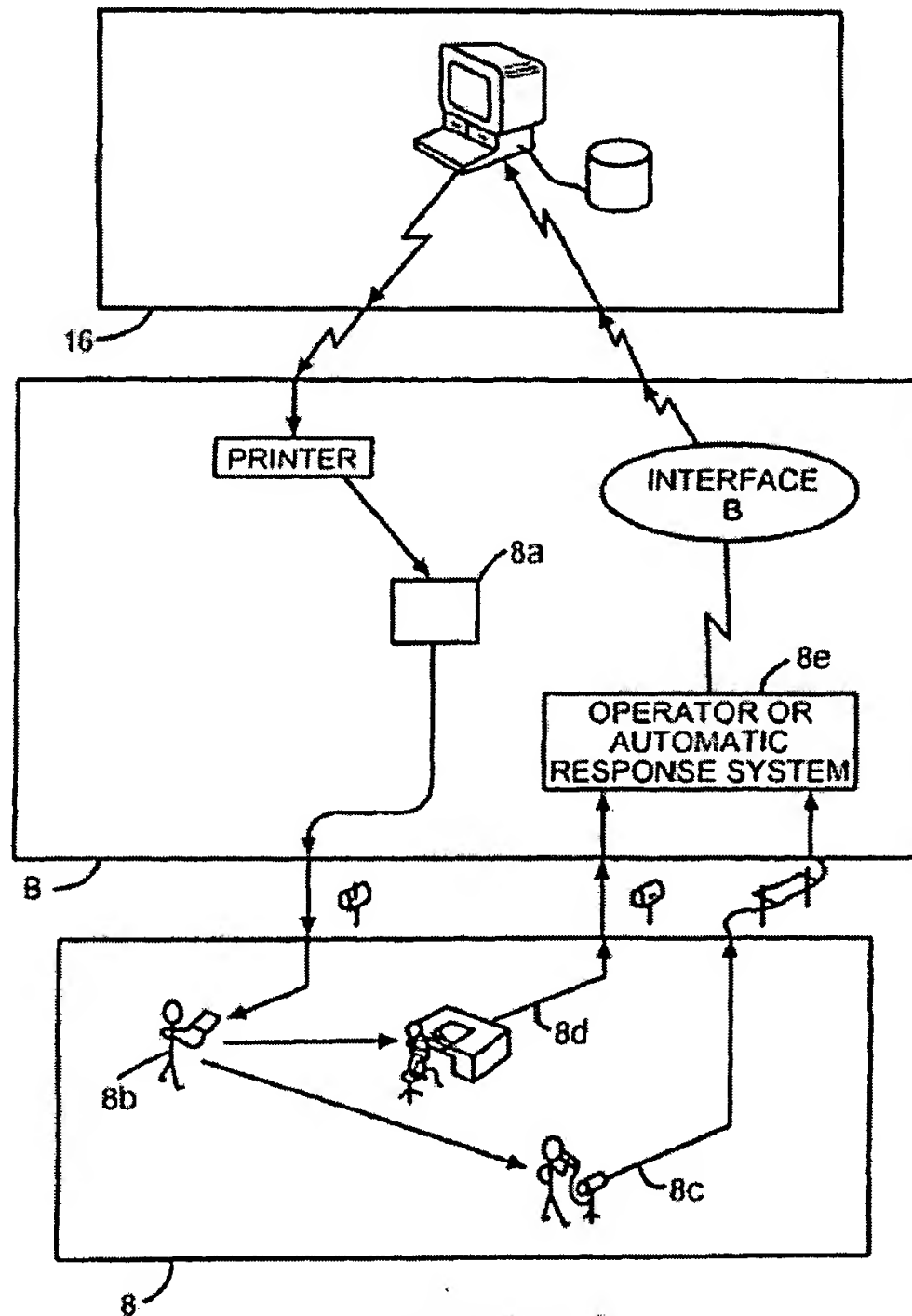
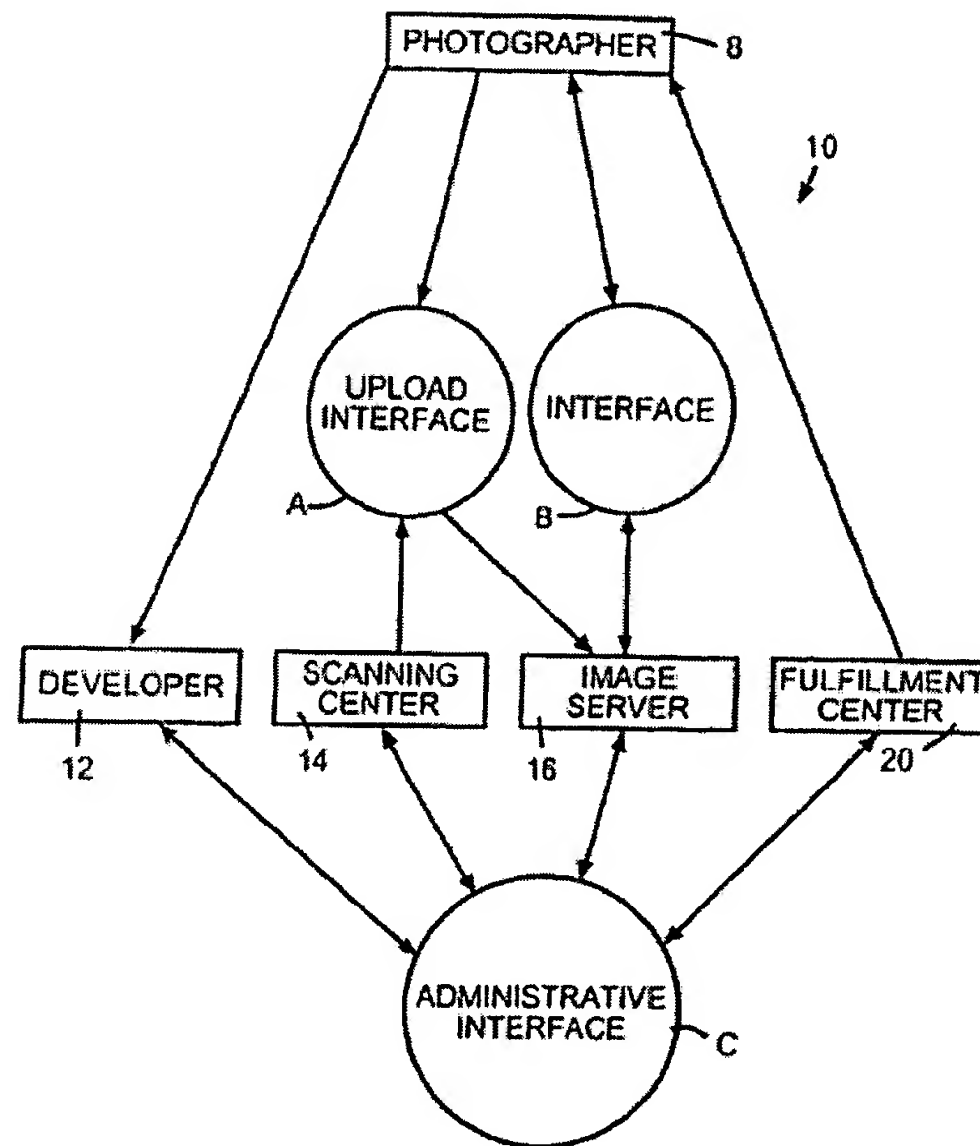


FIG. 8

Interface C interacts with the image server, fulfillment center, developer and scanning center only, not Interfaces A and B or the photographer as is highlighted in FIG. 1 of Garfinkle et al., which again is reproduced below for the convenience of the Board:

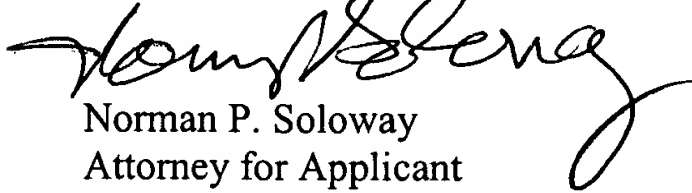


Nowhere does Garfinkle et al. teach a single subsystem, i.e., the headquarters terminal as required by claim 1, that has a receiver for receiving orders and image data from an orderer terminal and a transmitter for transmitting the order to the producing/processing terminal, thereby managing image data. Thus, Garfinkle et al. cannot anticipate independent claim 1, or dependent claims 2-14 which depend directly or indirectly thereon. Independent claims 15-18 contain similar claim language and are similarly allowable over the art.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner's Rejection of the subject Application be reversed in all respects.

Respectfully submitted,



Norman P. Soloway
Attorney for Applicant
Reg. No. 24,315

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 5, 2005, at Tucson, Arizona.

By 

NPS/ALK:lv

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567



APPENDIX A

Serial No. 09/855,149
Docket No. NEC 142135

CLAIMS ON APPEAL
filed with
APPELLANT'S BRIEF

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567



APPENDIX A

CLAIMS ON APPEAL:

Claim 1: A network commerce system comprising:

an orderer terminal for interaction with an orderer ordering an item or service;

a plurality of producing/processing terminals each for interaction with a producer/processor, said producer/processor producing and processing said item or providing a produced and processed item, in accordance with an order from said orderer terminal;

wherein said orderer terminal and said producing/processing terminal are interconnected via said network; and

a headquarters terminal including a receiver for receiving an image data order from said orderer terminal transmitted via said network and a transmitter for transmitting the order received by said receiver to a producing/processing terminal via said network;

said headquarters terminal selectively determining said producing/processing terminal in accordance with a received order and then making the selected producing/processing terminal produce and process said item or provide a produced and processed item.

Claim 2: The network commerce system defined in Claim 1, wherein said item or service is an item edited with digital data or editing of said digital data; and wherein said orderer terminal transmits said digital data together with said order; and wherein each of said producing/processing terminals receives said order and said digital data transmitted via said network and via said headquarters terminal and then edits said digital data in accordance with the content of said order.

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

Claim 3: The network commerce system defined in Claim 2, wherein said digital data comprises image data or acoustic data.

Claim 4: The network commerce system defined in Claim 2, further comprising a payment terminal connected to said network, for paying a purchase charge of said item sold or said service provided, via said orderer terminal.

Claim 5: The network commerce system defined in Claim 2, wherein said item or said service is delivered or supplied to a destination other than said orderer.

Claim 6: The network commerce system defined in Claim 3, further comprising a payment terminal connected to said network, for paying a purchase charge of said item sold or said service provided, via said orderer terminal.

Claim 7: The network commerce system defined in Claim 3, wherein said item or said service is delivered or supplied to a destination other than said orderer.

Claim 8: The network commerce system defined in Claim 2, wherein said digital data comprises image data or acoustic data.

Claim 9: The network commerce system defined in Claim 8, further comprising a payment terminal connected to said network, for paying a purchase charge of said item sold or said service provided, via said orderer terminal.

Claim 10: The network commerce system defined in Claim 9, wherein said item or said service is delivered or supplied to a destination other than said orderer.

Claim 11: The network commerce system defined in Claim 1, further comprising a payment terminal connected to said network, for paying a purchase charge of said item sold or said service provided, via said orderer terminal.

Claim 12: The network commerce system defined in Claim 11, wherein said item or said service is delivered or supplied to a destination other than said orderer.

Claim 13: The network commerce system defined in Claim 1, wherein said item or said service is delivered or supplied to a destination other than said orderer.

Claim 14: A headquarters terminal comprising:
orderer terminals each for interaction with an orderer ordering an item or service;
a plurality of producing/processing terminals each for interaction with a producer/processor which produces and processes said item or supplies a produced/processed item, in accordance with an order from each of said orderer terminals; and

a headquarters terminal including:

a receiver for receiving an order transmitted in image data form from said orderer terminal via said network;

a transmitter for transmitting an item received by said receiving means to a producing/receiving terminal via said network; and

a determinator for selectively determining said producing/processing terminal in accordance with a received order and then making said producing/processing terminal produce and process said item or making said selected producing/processing terminal supply said produced/processed item;

wherein a network commerce is performed between said orderer terminal and said producing/processing terminal connected via a network.

Claim 15: A producing/processing terminal comprising:

orderer terminals each for interaction with an orderer ordering an item or service;

a plurality of producing/processing terminals each for interaction with a producer/processor which produces and processes said item or supplies a produced/processed item, in accordance with an order from each of said orderer terminals; and

a headquarters terminal including:

a receiver for receiving an order transmitted in image data form from an orderer terminal via said network;

a transmitter for transmitting an order received by said receiver to a producing/processing terminal via said network; and

a determinator for selectively determining said producing/processing terminal in accordance with a received order and then making said producing/processing terminal produce and process said item or supply said produced/processed item;

wherein a network commerce is performed between said orderer terminal and said producing/processing terminal connected via a network.

Claim 16: An orderer terminal used in a network commerce system, said network commerce system comprising:

orderer terminals each for interaction with an orderer ordering an item or service;

a plurality of producing/processing terminals each for interaction with a producer/processor which produces and processes said item or supplies a produced/processed item, in accordance with an order from each of said orderer terminals; and

a headquarters terminal including:

a receiver for receiving an order transmitted in image data form from an orderer terminal via said network;

a transmitter for transmitting an item received by said receiver to a
producing/receiving terminal via said network; and

a determinator for selectively determining said producing/processing terminal in
accordance with a received order and then making said selected producing/processing
terminal produce and process said item or supply said produced/processed item;
wherein a network commerce is performed between a producing/processing terminal
and said headquarters terminal connected via a network.

Claim 17: A payment terminal used in a network commerce system, said network
commerce system comprising:

orderer terminals each for interacting with an orderer ordering an item or service;
a plurality of producing/processing terminals each for interacting with a
producer/processor which produces and processes said item or supplies a produced/processed
item, in accordance with an order from each of said orderer terminals; and

a headquarters terminal including:

a receiver for receiving an order transmitted in image data form from
said orderer terminal via said network;

a transmitter for transmitting an item received by said receiver to a
producing/receiving terminal via said network;

a determinator for selectively determining said producing/processing
terminal in accordance with a received order and then making said selected
producing/processing terminal produce and process said item or supply said
produced/processed item; and

a payment terminal for paying a purchase charge of said item or service sold or supplied via said orderer terminal;

wherein a network commerce is performed between said orderer terminal and said producing/processing terminal and said headquarters terminal, interconnected via a network.

Claim 18: A network commerce method, wherein an orderer terminal orders an item or service via a network and a producing/processing terminal sells said item or provides said service, in accordance with said order, the method comprising the steps of:

receiving said order transmitted in image data form from said orderer terminal via said network, using a headquarters terminal;

selectively determining a producing/processing terminal for said item in accordance with the content of said received order, using said headquarters terminal;

transmitting said order to said selected producing/processing terminal via said network;

making said selected producing/processing terminal produce and process said item or supply said produced/processed item; and

paying, when said order is received or after said produced/processed item is supplied, a purchase charge of said item or service via said orderer terminal.

HAYES SOLOWAY P.C.
130 W. CUSHING STREET
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567